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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,607	11/29/2000	Masayuki Homma	CANO:015	1179

7590 02/13/2003

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EXAMINER

KNAPP, JUSTIN R

ART UNIT

PAPER NUMBER

2183

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/725,607

Applicant(s)

HOMMA, MASAYUKI

Examiner

Justin Knapp

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2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07/01/02, 04/10/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Papers Submitted***

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Change of Telephone Number as received 07/01/02, Fee and Claim of Foreign Priority as received 04/10/01.

### ***Priority***

2. Acknowledgement is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Takimoto, United States Patent Number 6,202,092.

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5. Referring to claim 1, Takimoto has taught a peripheral device control system comprising:

a) a peripheral device including a history information storage means for storing history

information including a user ID of a user who used said peripheral device, an operating mode of said peripheral device and a number of sheets discharged from said peripheral device (see figure 4, element 54);

b) an information processing apparatus including history information acquisition means for transmitting a history information acquisition job to said peripheral device and for acquiring said history information stored by said history information storage means (history information is transmitted and acquired through a network connection, see figure 4, elements 42 and 51), and storage means for storing said history information acquired by said history information acquisition means as a paper discharge counter table for every operating mode of said peripheral device (see figure 1, element 22d and 23 and figures 3a and 3b);

c) a network that connects said information processing apparatus to said peripheral device (see figure 4, elements 42 to 51 establish a network).

6. Referring to claim 2, Takimoto has taught a peripheral device control system wherein said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see column 3, lines 17-20 and figures 3a and 3b).

7. Referring to claim 3, Takimoto has taught a peripheral device control system wherein said peripheral device comprises:

a) job receiving means for receiving said history information acquisition job transmitted from said information processing apparatus (jobs are received via a network adapter, figure 4, element 51);

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b) transmission means for transmitting said stored history information according to said history information acquisition job received from said job receiving means (jobs also transmitted via a network adapter, figure 4, element 51).

8. Referring to claim 4, Takimoto has taught a peripheral device control system wherein said peripheral device comprises notification means for notifying said information processing apparatus of an amount of said history information stored by said history information acquisition means (see column 5, lines 57 to end and column 6). A notification means is inherent to update the history information.

9. Referring to claim 5, Takimoto has taught a peripheral device control system wherein said notification means notifies said information processing apparatus when said amount of history information reaches a predetermined amount (see column 5, lines 57 to end and column 6). If a predetermined amount is reached, the print request is rejected therefore a notification means must be used to notify the information processing apparatus to update the history information.

10. Referring to claim 6, Takimoto has taught a peripheral device control system, wherein said peripheral device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Takimoto has a printer as a peripheral device that provides a printer function (see figure 1, element 3).

11. Referring to claim 7, Takimoto has taught a peripheral device, which is connected to an information processing apparatus through a network, said peripheral device comprising:

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a) history information storage means for storing history information including a user ID of a user who used said peripheral device, an operating mode of said peripheral device, and a number of sheets discharged from said peripheral device (see figure 4, element 54);

b) history information transmission means for transmitting said history information stored by said history information storage means in response to a history information acquisition job transmitted from said information processing apparatus (jobs are transmitted to the information processing apparatus via a network adapter, figure 4, element 51).

12. Referring to claim 8, Takimoto has taught a peripheral device said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see column 3, lines 17-20 and figures 3a and 3b).

13. Referring to claim 9, Takimoto has taught a peripheral device comprising:

a) job receiving means for receiving said history information acquisition job transmitted from said information processing apparatus (network adapter, figure 4, element 51, provides a job receiving means);

b) transmission means for transmitting said stored history information according to said history information acquisition job received from said job receiving means (network adapter, figure 4, element 51, provides a transmission means for transmitting information).

14. Referring to claim 10, Takimoto has taught a peripheral device comprising notification means for notifying said information processing apparatus of an amount of said history information stored by said history information storage means (see column 5, lines 57 to end and column 6). A notification means is inherent to update the history information.

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15. Referring to claim 11, Takimoto has taught a peripheral device wherein said notification means notifies said information processing apparatus when said amount of history information reaches a predetermined amount (see column 5, lines 57 to end and column 6). If a predetermined amount is reached, the print request is rejected therefore a notification means must be used to notify the information processing apparatus to update the history information.

16. Referring to claim 12, Takimoto has taught a peripheral device wherein said peripheral device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Takimoto has a printer as a peripheral device that provides a printer function (see figure 1, element 3).

17. Referring to claim 13, Takimoto has taught an information processing apparatus connected to a peripheral device having history information storage means for storing history information including a user ID of a user who used said peripheral device, an operating mode of said peripheral device, and a number of sheets discharged from said peripheral device, said information processing apparatus comprising:

- a) history information acquisition means for transmitting a history information acquisition job to said peripheral device and for acquiring said history information stored by said history information storage means according to said history information acquisition job (network adapter, figure 4, element 42, provides transmission and acquisition means);
- b) storage means for storing said history information acquired by said history information acquisition means as a paper discharge counter table for every operating mode of said peripheral device (see figures 3a and 3b and figure 1, element 22d).

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18. Referring to claim 14, Takimoto has taught an information processing apparatus wherein said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see column 3, lines 17-20 and figures 3a and 3b).

19. Referring to claim 15, Takimoto has taught an information processing apparatus wherein said peripheral device comprises:

a) job receiving means for receiving said history information acquisition job transmitted from said information processing apparatus;

b) transmission means for transmitting said stored history information according to said history information acquisition job received from said job receiving means (network adapter, figure 4, element 42, provides job receiving and transmission means).

20. Referring to claim 16, Takimoto has taught an information processing apparatus wherein said peripheral device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Takimoto has a printer as a peripheral device that provides a printer function (see figure 1, element 3).

21. Referring to claim 17, Takimoto has taught a history information transmission method for a peripheral device connected to an information processing apparatus through a network, said method comprising the steps of:

a) storing history information including a user ID of a user who used said peripheral device, an operating mode of said peripheral device, and a number of sheets discharged from said peripheral device (statistical information managing portions store this information in the peripheral device and information processing apparatus as taught);



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b) transmitting said history information stored in said history information storage step to said information processing apparatus in response to a history information acquisition job transmitted from said information processing apparatus (network adapters on peripheral device and information processing apparatus provide transmission means as taught).

22. Referring to claim 18, Takimoto has taught a method wherein said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see column 3, lines 17-20 and figures 3a and 3b).

23. Referring to claim 19, Takimoto has taught a method comprising the steps of:

a) receiving said history information acquisition job transmitted from said information processing apparatus;

b) transmitting said stored history information according to said history information acquisition job received from said job receiving means (network adapter, figure 4, element 42, provides job receiving and transmission means).

24. Referring to claim 20, Takimoto has taught a method comprising the step of: notifying said information processing apparatus of an amount of said history information stored (see column 5, lines 57 to end and column 6). A notification means is inherent to update the history information.

25. Referring to claim 21, Takimoto has taught a method wherein said notifying step is executed to notify said information processing apparatus when said amount of history information reaches a predetermined amount (see column 5, lines 57 to end and column 6). If a predetermined amount is reached, the print request is rejected therefore a notification means must be used to notify the information processing apparatus to update the history information.

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26. Referring to claim 22, Takimoto has taught a method wherein said peripheral device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Takimoto has a printer as a peripheral device that provides a printer function (see figure 1, element 3).

27. Referring to claim 23, Takimoto has taught a peripheral device control method of controlling a peripheral device having history information storage means for storing history information including a user ID of a user who used said peripheral device, an operating mode of said peripheral device, and a number of sheets discharged from said peripheral device, said method comprising the steps of:

- a) transmitting a history information acquisition job to said peripheral device, for acquiring said history information stored by said history information storage means according to said history information acquisition job (network adapters provide a transmission means as taught);
- b) storing said history information acquired in said history information acquisition step as a paper discharge counter table for every operating mode of said peripheral device (see figures 3a and 3b and figure 4, element 54).

28. Referring to claim 24, Takimoto has taught a method wherein said operating mode includes at least one of a paper size, a one-side/double-side printing mode, a toner color, and a paper type (see column 3, lines 17-20 and figures 3a and 3b).

29. Referring to claim 25, Takimoto has taught a method wherein said peripheral device executes the steps of:

- a) receiving said history information acquisition job transmitted from said information processing apparatus;

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b) transmitting said stored history information according to said history information acquisition job received (network adapter, figure 4, element 42, provides job receiving and transmission means).

30. Referring to claim 26, Takimoto has taught a method wherein said peripheral device includes at least one of a printer function, a copying function, a facsimile function, and a scanner function. The system of Takimoto has a printer as a peripheral device that provides a printer function (see figure 1, element 3).

### *Conclusion*

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (703) 308-6132. The examiner can normally be reached on Mon - Fri 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan can be reached on (703) 305-9712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Justin Knapp  
Examiner  
Art Unit 2183

February 7, 2003



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.